

REMARKS

Claims 1 through 3 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner asserted that the claims do not identify what Applicants regard as their invention because claim 1 does not include the limitation “from other types of sebum” although the claims do recite that the claimed paper is “selectively capable of absorbing oxidized sebum.” This rejection is traversed as legally erroneous.

Firstly, it is not for the Examiner to tell Applicants what Applicants regard as their invention. Applicants have defined what they regard as their invention. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979); *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970).

Applicants have defined their invention as a sebum absorbing paper which is “selectively capable of absorbing oxidized sebum.” The Examiner has no difficulty understanding what the “selectively capable of absorbing oxidized sebum” limitation means, because in the sentence bridging pages 2 and 3 of the March 30, 2005 Office Action, the Examiner recognizes that it means “selectively absorbing oxidized sebum from other types of sebum.” Now the Examiner says the limitation “from other types of sebum” must be incorporated into the claims. The Examiner is legally wrong.

The Examiner is legally wrong because the issue here is not importing a limitation into the claims but **interpreting a limitation which is already in the claims**. That limitation is “selectively capable of absorbing oxidized sebum.” The issue distills to what that expression means. It means what one having ordinary skill in the art would have interpreted it to mean in light of and consistent with the written description of the specification. In interpreting that limitation “selectively capable of absorbing oxidized sebum”, as the Examiner appreciates, one

having ordinary skill in the art would have recognized that the claimed paper selectively absorbs oxidized sebum from other types of sebum. This is not a matter of importing a limitation into a claim, but of **interpreting a limitation already present in the claims**. There is no legal basis upon which the Examiner can insist upon incorporating an interpretation of a claim limitation into a claim.

Applicants submit that one having ordinary skill in the art would have no difficulty understanding the expression “capable of absorbing oxidized sebum” in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993). Again, the limitation “capable of absorbing oxidized sebum” is already in the claims. What is at issue is how it is interpreted. This is not really an issue because the Examiner admits in the sentence bridging pages 2 and 3 of the March 30, 2005 Office Action that it means selectively absorbing oxidized sebum from other types of sebum. There is no legal basis upon which the Examiner can require the incorporation of an interpretation of a claim limitation into a claim.

Applicants, therefore, submit that the imposed rejection of claims 1 through 3 under the second paragraph of 35 U.S.C. § 112 is not legally viable and, hence, solicit withdrawal thereof.

The withdrawn rejections

The Examiner has **withdrawn** the rejections under 35 U.S.C. § 102(f) based upon each of JP 2002330820 (JP ‘820) and JP 2003038248 (JP ‘248). The Examiner now wants affidavits pursuant to 37 C.F.R. § 1.132 to establish that they are the inventors of the present application.

The Examiner already has a Declaration to that effect filed with the application. The Examiner has **no** basis upon which to **challenge the Declaration filed** with the application. As

recognized by the Examiner, the relied upon disclosures in JP '820 and JP '248 are just that – disclosures not claims. The inventors of JP '820 and JP '248 do not lay claim to the portions of the disclosure previously relied upon by the Examiner. Since there are no pending rejections, the Declaration filed with the application must be accepted. Accordingly, the Examiner is requested to withdraw his requirement for affidavits under 37 C.F.R. § 1.132.

Claims 1 through 3 were rejected under 35 U.S.C. § 103 for obviousness predicated upon EP 0 393 723 (EP '723) in view of JP 11-137336 (JP '336), Fujii et al., and JP 63188628 (JP '628) or JP 63027411 (JP '411).

In the statement of rejection the Examiner merely identified features in each of the applied references, erroneously referred collectively to the five applied references as “the prior art” and then concluded, in the second full paragraph on page 6 of the March 30, 2005 Office Action:

As such, one of ordinary skill in the art would have been motivated to modify the prior art (What prior art?) as above with the expectation that a paper containing hydroxypapatite and talc would be suitable for absorbing oxidized sebum from the skin because hydroxypapatite powders are known to be effective in absorbing oxidized lipids from the skin.

This rejection is traversed as factually and legally erroneous.

Violation of Applicants' Right to Due Process of Law

The Examiner is depriving Applicants of procedural due process of law by **not** complying with the requirements of *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966) and failing to apprise Applicants of the precise reasons **why the claimed subject matter as a whole would have been obvious to one having ordinary skill in the art.** *In re Mullin*, 481 F.2d 1333, 179 USPQ 97 (CCPA 1973). Specifically, on pages 5 and 6 of the

March 30, 2005 Office Action, the Examiner identifies wherein perceived features reside in disparate references. The Examiner then, in the third paragraph on page 6, talks about the “The difference between the prior art and the claimed invention...” What prior art? There are five references. The Examiner is beginning with a **primary reference EP ‘723**, but **never** offers any reason why one having ordinary skill in the art would have been **motivated** to modify that reference to arrive at the claimed invention. The Examiner just **assumes** that one having ordinary skill in the art “would have been motivated to modify the prior art as above”. But the Examiner does explain to Applicants **what particular prior art** is proposed to be modified, how it is to be modified and importantly, **why based on facts**. This is a complete failure to articulate a rejection under 35 U.S.C. § 103 and, hence, deprives Applicants of their rights under due process of law. *In re Mullin, supra*. For this reason alone the rejection should be withdrawn.

There is no motivation.

In order to establish the requisite realistic motivation, the Examiner must make clear and particular **factual findings** as to a **specific understanding or specific technological principle** and then, based upon such **facts**, explain **why** one having ordinary skill in the art would have been realistically motivated to modify a **specific prior art**, in this case presumably the papers and nonwoven fabrics of EP ‘723, to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison, Co.* 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). This burden has **not** been discharged. As pointed out above, the Examiner has identified features in the applied references and then

announced the obviousness conclusion without complying with judicial requirements requiring clear and particular factual findings and reasons based upon such findings. Instead what the Examiner has done is pointed to isolated features and then announced the obviousness conclusion. This approach is **legally erroneous**. *In re Dembiczak, supra; Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).*

Leaving aside the Examiner's legally improper generalizations as to the motivational issue, there is no factual basis to support the motivational element. As pointed out in the Appeal Brief of December 15, 2004, the primary reference to EP '723 is not directed to a paper used for applying to skin or for cleaning the skin as recited in claim 1, nor is it apparent that it is even capable of even discharging that function. Certainly, there is no factual basis to establish it is **capable of selectively absorbing oxidized sebum**, as in the claimed invention.

JP '336 is completely **silent** with regard to hydroxypapatite. The references JP '628 and JP '411 relate to a hydroxypapatite in a cosmetic product. But JP '411 does **not** disclose a **paper** product as in the claimed invention, or that the hydroxypapatite would be effective for absorbing lipids. JP '628, of course, is not even related to a paper product.

The above disparate references were previously relied upon and, when confronted with the December 15, 2004 Appeal Brief, the Examiner retreats, rewires the rejection and includes Fujii et al. But the reference to Fujii et al. does **not** help. Fujii et al. merely disclose implant materials having a good compatibility with a living organism. The reference to Fujii et al. is **remote** to "sebum absorbing paper" and certainly sheds no light on "selectively absorbing oxidized sebum."

Moreover, the reference to Fujii et al. relates to nonwoven fabrics – not paper as in the claimed invention. The Examiner has not provided any factual basis upon which to predicate the conclusion that nonwoven fabrics are suitable for use as a sebum absorbing paper, let alone to selectively absorb oxidized sebum.

Further, the broad range of the weight basis, i.e., 5 g/m² to 500 g/m² (column 7, lines 32 through 35) can hardly be said to direct one having ordinary skill in the art to the claimed invention, particularly as the weight basis of 200 g/m² is exemplified (example 6 and 7). This is a very different product from the present invention having a weight basis of 5 g/m² to 25 g/m².

Applicants would stress that none of the applied prior art expresses any recognition for the problem of selectively absorbing oxidized sebum. This failure of the applied prior art underscores the lack of motivation. As held by the Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison, Co. supra*, at 56 USPQ2d 1076:

...There must still be evidence that “a skilled artisan,” confronted with the **same problems as the inventor** and with no knowledge of the claimed invention, would select the elements from the cited prior art references for a combination in the manner claimed.” (emphasis applied)

The Examiner does not gainsay that the applied references are mute as to selectively absorbing oxidized sebum. Nevertheless, the Examiner assumes that the claimed invention would have been obvious because the Examiner has identified perceived features of the claimed invention in these disparate references. There is no automatic motivation, particularly in the present situation where the references are conspicuously silent as to the problem addressed and solved by the claimed invention.

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, there is a potent indicium of non-obviousness which the Examiner failed to consider.

Indicium of non-obviousness

It is well settled that the problem addressed and solved by the claimed invention must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). It should be apparent from the present specification that the problem addressed and solved by the claimed invention resides in formulating an absorbing paper which will selectively absorb oxidized sebum vis-à-vis old sebum. That problem is not even a blip on the radar screens of the applied prior art. This being the case, the problem addressed and solved by the claimed invention must be given consideration as a potent indicium of nonobviousness under 35 U.S.C. § 103.

Conclusion

As previously argued, the Examiner failed to establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the problem of selectively absorbing oxidized sebum which is addressed and solved by the claimed

invention, and the failure of the applied prior art to appreciate that problem, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the **claimed subject matter as a whole**, obviousness within the meaning of 35 U.S.C. § 103. *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

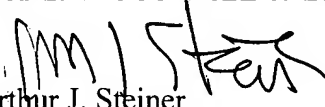
Applicants, therefore, submit that the imposed rejection of claims 1 through 3 under 35 U.S.C. § 103 for obviousness predicated upon EP '723 in view of JP '336, Fujii et al., and JP '628 or JP '411 is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 :MWE:ntb
Date: August 23, 2005

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